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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,671

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Anders Vikso Nielsen

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EXAMINER

MACAULEY, SHERIDAN R

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

02/12/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,671	<b>Applicant(s)</b> NIELSEN ET AL.	
	<b>Examiner</b> SHERIDAN R. MACAULEY	<b>Art Unit</b> 1651	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 28-46 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 28-39, 42 and 44-46, drawn to a process for producing a soluble starch hydrolysate. *Note that election of this group will also require an election of species. See species election requirement below.*

Group II, claim(s) 40, drawn to a process for the production of high fructose starch-based syrup.

Group III, claim(s) 41 and 43, drawn to a process for production of a fermentation product. *Note that election of this group will also require an election of species. See species election requirement below.*

2. The inventions listed as Groups I through III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The technical feature that is common to the groups is the process described in claim 28. However, at the time of the invention, a process comprising all of the claimed steps was known, as taught by Jackson (EP 0171218, document cited in IDS). Jackson teaches a method for producing a soluble starch hydrolysate from an aqueous granular starch slurry at 55 degrees C (below the gelatinization temperature) wherein the slurry is subjected to the action of glucoamylase and other enzymes, such as alpha amylase (pp. 40-41 example 3, p. 20, last paragraph). Although Jackson does not teach enzymes with the specific amino acid sequences recited in the claim, Callen (WO 02/068589, document cited in IDS) teaches an alpha amylase with greater than 60% sequence similarity to SEQ ID NO: 2 and SEQ ID NO: 3 (see SEQ ID NO: 63). One of ordinary skill in the art would have recognized that the selection of an alpha amylase for use in the method of Jackson would have been a routine matter of obviousness, especially since Callen teaches that the alpha amylases have increased activity and stability (abstract). Therefore, the technical feature that is common to the groups makes

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no contribution over the prior art and there is no special technical feature uniting the claimed inventions.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

For Group I, election is required of the amino acid sequences recited in claim 28.

Applicant may elect SEQ ID NO: 1, SEQ ID NO: 2 or SEQ ID NO: 3.

For Group III, election is required of the various fermentation products recited in claim 41. For example, applicant may elect citric acid, gluconic acid, or lactic acid.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. The claims are deemed to correspond to the species listed above in the manner described above.

The following claim(s) are generic: none.

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5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The technical feature that is common to the species is the process described in claim 28. However, at the time of the invention, a process comprising all of the claimed steps was known, as taught by Jackson (EP 0171218, document cited in IDS). Jackson teaches a method for producing a soluble starch hydrolysate from an aqueous granular starch slurry at 55 degrees C (below the gelatinization temperature) wherein the slurry is subjected to the action of glucoamylase and other enzymes, such as alpha amylase (pp. 40-41 example 3, p. 20, last paragraph). Although Jackson does not teach enzymes with the specific amino acid sequences recited in the claim, Callen (WO 02/068589, document cited in IDS) teaches an alpha amylase with greater than 60% sequence similarity to SEQ ID NO: 2 and SEQ ID NO: 3 (see SEQ ID NO: 63). One of ordinary skill in the art would have recognized that the selection of an alpha amylase for use in the method of Jackson would have been a routine matter of obviousness, especially since Callen teaches that the alpha amylases have increased activity and stability (abstract). Therefore, the technical feature that is common to the species makes no contribution over the prior art and there is no special technical feature uniting the claimed inventions.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHERIDAN R. MACAULEY whose telephone number is (571)270-3056. The examiner can normally be reached on Mon-Thurs, 7:30AM-5:00PM EST, alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRM  
/Ruth A. Davis/  
Primary Examiner, Art Unit 1651